

C. REMARKS

Applicants wish to express their appreciation to Supervisory Patent Examiner Lynette Smith and to Examiner Hynes for the time taken and courtesies extended to their representative during the April 2 interview. It is believed that this interview was very helpful in moving this case toward final disposition.

Claims 51-58, 60 & 61 are pending. Claim 51 is amended as discussed during the interview. Specifically, the language of the claim now refers to transcript as RNA or cDNA, and incorporates language from claim 1 of U.S. Patent No. 5,846,824, which is the great , great grandparent of the present application.

The use of RNA and cDNA as transcript is described in the specification, starting at page 38. For example, at page 38, a cDNA library provides transcript. Such is also the case at page 39 (RACE PCR). RNA is used in the Northern Transfer hybridization at page 40. Hence, there is ample support for this recitation.

Proposed drawings are appended hereto. Note that they come from the issued '824 patent, thereby obviating the objection at point 4.

The amendment to claim 51 is believed to obviate the objection to claim 58. Claim 51 clearly recites "RNA or cDNA" in the alternative, and is broader than claim 58.

Turning to the rejection under 35 USC §112 at point 8 of the office action, this was discussed extensively at the interview. Applicants' learned that the rejection is based, essentially, on two issues: (i) recitation of specifics of the target, and (ii) recitation of specifics of the molecules used to identify the targets.

With respect to the first issue, applicants proposed the language added in claim 51, which the examiners agreed would suffice.

With respect to (ii), Examiner Hynes suggested that incorporating claim 56 into the main claim would obviate the issue. Applicants indicated that they would not do so, for the following reasons.

Over 500 oligonucleotides are disclosed as hybridization partners for the target. This was pointed out in the Amendment filed on May 23, 2001.

It is agreed that the "Interim Written Description Guidelines" do not provide information on the minimum number of species necessary to support a genus; however, it is believed that

500+ examples should be sufficient, especially since the guidelines provide that even one example can be sufficient.

The claims recite specific information about the transcript that is the target. The sequences described in the specification all show a high degree of complementarity. Given a specific target, one of ordinary skill in the art could easily develop hybridization reagents, and vary them, since it is well known that hybridization does not require 100% complementarity.

For these reasons, it is believed that the nature of the hybridization partner need not be specified, and the rejection should be withdrawn.

Turning to point 9 of the action, applicants have cancelled claim 59; however, with respect to the rest of the rejection, it was pointed out during the interview that if transcript is present, then the gene must be present. Further, if transcript is present, then the gene has been expressed. This is basic molecular biology.

It is believed that the examiners accepted this, as it was indicated that the rejection at point 9 would be withdrawn.

With respect to the rejection at point 10, label is not necessarily to carry out the claimed assays. Applicants pointed out that it is undoubtedly true that sometimes a label is very desirable and is used. See, e.g., page 38, where ^{32}P is incorporated into the reaction; however, this is not necessary. Applicants draw the examiner's attention to the RACE PCR work at page 39, where ethidium bromide staining was used. The staining takes place after the hybridization does, and is a standard technique. The technique was used in "PCR determination of p85 α and p110 mRNA" at page 41 as well. Hence, label is not required. Nor are any of the steps set forth at the top of page 10 required, as the examples show.

Turning finally to point 11, Examiner Hynes stated during the interview that should all other points be addressed, point 11 would be moot. As all other points have been addressed, it is believed to be moot.

Withdrawal of the rejections, and allowance of claims 51-58, 60 & 61 is believed proper and is urged.

Respectfully submitted,

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